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EXAMINER
STEELMAN, MARY J

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 March 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to Claims and Remarks received 3/7/2006. Claims 1-20

are pending.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because claims are directed towards non-

statutory subject matter.

Claims 1-12 are fail to result in a physical transformation of a practical application

established as a useful, concrete, tangible result. Claims recite 'determining', which are not

tangible results, under the current 35 USC 101 guidelines.

Additionally, Claim 9 appears to be software per se, and as such is non-staturory.

Claims 13-20 recite a computer readable medium. As defined in the Specification (page

19, lines 5-15) some embodiments appear to be statutory. However, at page 19, line 16, it

appears that Applicant intends for the definition to include 'carrier waves' and 'signals', which

are not statutory embodiments.

Claims 13-20 fail to result in a physical transformation of a practical application

established as a useful, concrete, tangible result. Claims result in 'determining', 'consulting',

'providing', which are not tangible embodiments, under the current 35 USC 101 guidelines.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4.   Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim limitation recites "A computer readable medium containing a method..." A method is a series of acts or steps. Examiner fails to see how a computer readable medium can contain acts or steps. It can contain executable code or instructions which cause a computer or other machine to perform a method. As currently stated the claim is not enabled.

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: A computer readable medium tangibly embodying a method (such a method providing steps or acts of determining, to be followed by a tangible concrete result).

Response to Arguments

7.   Applicant has argued, in substance, the following:

(A) Regarding independent claim 1, as Applicant has noted on page 7, second paragraph, of Remarks, Lichtenberg fails to describe, "if a new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and the new part."

Examiner's Response:

Examiner disagrees. A new part that is not compatible may be selected. [0105]-A user may choose a 'selected alternative' ([0102]), that is found to be 'not compatible' (new part is not compatible with one or more existing parts), and resolve the incompatibility by determining a replacement for an existing part. [0383]-A user may choose a new part that is not compatible, then 'sacrifice some earlier selections' (determine a replacement for an existing incompatible part). [0406]- "Even though this selection is not compatible with other selection (new part is not compatible with one or more existing parts), force this selection, sacrificing other selections..." [0407-0412], explains that the 'forced selection' (new part is not compatible with one or more existing parts) will be added to the product configuration, requiring new selection (determine a replacement for an existing incompatible part) of previously selected parts. [0383], The user is able to undo previous selections and re-select a replacement part to satisfy compatibility.

(B) Regarding independent claim 9, as Applicant has noted on page 9, 4th paragraph, Lichtenberg fails to describe, "a replacement component which determines replacement parts for one of existing parts and new parts if a determination of incompatibility is made."

Examiner's Response:

Examiner disagrees. See response to (A) above.

(C) Regarding independent claim 13, as Applicant has noted on page 10, last paragraph, of

Remarks, Lichtenberg fails to describe, "a data structure comprising a plurality of records in a

table, each recording including: (1) at least two product identification values, said values

representing that said products represented by said identification values are incompatible; and (2)

an indication as to product identification values which are suitable replacements for at least one

of said product identification values entered in said record."

Examiner's Response:

See "The Product Model" beginning at [0234]. [0235]-"The product model is used to describe

what component the product is composed of and the inter-dependencies between these

components." [0237]-"An example of a product model..." A data structure shows a plurality of

records with identification values (such as motherboard.name=Aopen-AX6BP-AXT). Such

values are used to represent products with compatible choices represented as an attribute through

the use of rules. Suitable replacements are indicated in the rules. [0238-0240]-"Generally, the

rules can express any relationship between product variables, but the concrete rules presented in

this example can be thought of as divided into two different categories: Attribute rules

specifying the value of a certain attribute for a specific alternative...Compatibility rules

specifying general interdependencies between alternatives/attributes from different

components..." Lichtenberg discloses identification values, said values are used to represent

products that are incompatible. These 'values representing that said products represented by said

identification values are incompatible' will be recognized as incompatible when applying the

rules.

Also see [0242], "the product tables are used to capture the concrete alternatives (indication as to

product identification values which are suitable replacements) for the components as well as the

concrete values for the attributes. Further examples of suitable replacements are disclosed at

[0036-0039]. For each component, information relating to a group of alternatives is provided,

rules relating to compatibilities are defined and represented in a DAG. The DAG (has encoded

indications as to product identification values and suitable replacements) is checked during the

selections process to determine compatibility [0028-0034].

(D) Regarding independent claim 14, as Applicant has noted on page 12, second paragraph, of

Remarks, Lichtenberg fails to describe, "a computer readable medium containing a method that

comprises determining a replacement part for one of an existing incompatible part and a new part

if the new part is not compatible with one or more existing parts."

Examiner's Response: Examiner disagrees. See response to (A) above.

(E) Regarding claims 6, 11, and 19, as Applicant has noted on page 14, second paragraph, there

is no motivation to modify the Lichtenberg reference.

Examiner's Response:

Examiner disagrees. Lichtenberg disclosed a part compatibility table (See [0234]-"The Product

Model"). Inherently, that which is not indicated as compatible, is incompatible. Such a

determination will be discovered by applying the rules ([0249]). Lichtenberg disclosed

determining incompatibility by using a DAG that is based on rules derived from a product table.

[0274]-A DAG will represent all the rules, such that enquiries about valid solutions to the rules

can be performed efficiently."

It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to

modify Lichtenberg's invention, to store 'incompatible' information in a table because one of

ordinary skill in the art would use such a data structure to logically organize information to

improve access and storage.

(F) Regarding claims 3 and 16, as Applicant has noted on page 14, last paragraph, there is no

suggestion to combine the Forth reference with the Lichtenberg reference.

Examiner's Response:

Examiner disagrees. It would have been obvious, to one of ordinary skill in the art, at the time of

the invention, to modify Lichtenberg's invention of configuring a product of compatible parts, to

include the situation that should a part not be available, that an alternative new part may be

provided, because one of ordinary skill in the art would be motivated to make an alternate

selection, to substitute for a part that is not available, thereby producing a finished product.

Both inventions recognized the need to simplify the selection process. Lichtenberg recognized

the need to simplify the (Lichtenberg: [0026]) "computational problems inherent in developing a

program for computer assisted configuration", (Lichtenberg: [0049]) enabling "the user to

quickly be able to progress in the configuring of the product." Likewise, Forth recognized the

(Forth: col. 1, line 40) "increased demand" for configured products, which can be (Forth: col. 2,

lines 2-4) "tedious, time consuming and resource intensive, i.e. expensive, process requiring

highly skilled personnel."

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 1, 2, 4, 5, 7-10, 12-15, 17, 18, and 20 are rejected under 35 U.S.C. 102(e) as being

anticipated by US Patent Application Publication 2002/0165701 A1 to Lichtenberg et al.

Lichtenberg disclosed:

Per claims 1, 8, and 14:

A method / system / computer readable medium in a computing environment for determining

compatibility of parts in a selected product configuration, the method comprising:

[0001] a method for configuring a product, where compatibility (interdependencies) of parts selected are considered when selecting parts for product configuration. A computer system capable of determining the compatibility of parts in a product configuration is disclosed in Figs. 3-9, which depict a computer exemplifying Lichtenberg's invention for configuring a product. Lichtenberg disclosed a computer readable medium version of a compatible configuration selection process at [0194-0195].

-determining whether a new part is compatible with one or more existing parts of the product configuration;

As an example, at [0029-0034], providing and defining rules relating to compatibilities is disclosed. A rules / constraints based reasoning technique is provided in the form a Directed Acyclic Graph (DAG) whereby choices made for a part selection are checked for compatibility (determining whether a new part is compatible) using the DAG.

-if said new part is not compatible with one or more existing parts, determining a replacement part for one of an existing incompatible part and said new part.

A new part that is not compatible may be selected. [0105]-A user may choose a 'selected alternative' ([0102]), that is found to be 'not compatible'(new part is not compatible with one or more existing parts), and resolve the incompatibility by determining a replacement for an existing part. [0383]-A user may choose a new part that is not compatible, then 'sacrifice some earlier selections' (determine a replacement for an existing incompatible part). [0406]- "Even

though this selection is not compatible with other selection (new part is not compatible with one

or more existing parts), force this selection, sacrificing other selections..." [0407-0412],

explains that the 'forced selection' (new part is not compatible with one or more existing parts)

will be added to the product configuration, requiring new selection (determine a replacement for

an existing incompatible part) of previously selected parts. [0383], The user is able to undo

previous selections and re-select a replacement part to satisfy compatibility.

Per claims 2 and 15:

-replacing said existing incompatible part with a compatible alternative existing part.

[0383], After 'forcing' the selection of a part that causes the product configuration to be

incompatible due to previously selected existing parts (earlier selections / existing incompatible

part), a configuration assistant, using the DAG, provides for sacrificing earlier selections / de-

selecting previously selected parts to achieve compatibility. [0407-0412] a selection list, S', is

initialized to an empty list and new selections, s (compatible alternative existing part), are added

if compatible.

Per claims 4 and 17:

-determining whether said new part is compatible with the product configuration.

Lichtenberg described a DAG used to verify compatibility of selections. Iteratively, as each new

part is selected, it is checked for compatibility, using a DAG that represents the compatibility

rules according to specified product configuration. See [0028-0034].

Per claims 5 and 18:

-consulting a product table to determine whether said new part is compatible with the product

configuration.

As an example, product tables are disclosed at [0242] that define components and attributes.

[0249], Tables are translated to rules. [0268], "A rule is a Boolean expression over the product

variables that should be satisfied of the configuration to be consistent" (product table used to

determined whether said new part is compatible with the product configuration).

Per claims 7 and 20:

-determining whether said new part is incompatible with one or more base parts of the product

configuration, wherein if said new part is incompatible with one or more base parts, an

alternative new part is provided.

Lichtenberg disclosed an iterative selection process that allows for a 'new part that is

incompatible" with base parts (previously selected components) to provide an alternative new

part at [0096]. As an example, [0107] & [0109] discloses a database of alternatives.

Per claim 9:

A computer system capable of determining the compatibility of parts in a product configuration,

the computer system comprising:

A computer system capable of determining the compatibility of parts in a product configuration

is disclosed in Figs. 3-9, which depicts a computer exemplifying Lichtenberg's invention for

configuring a product.

-a compatibility component which determines whether a selected part is compatible with existing

parts of the configuration;

A DAG (compatibility component) is disclosed [0275 - 0276] that represents all rules and every

consistent (compatible) configuration. A Boolean Decision Diagram (BDD) [0282] is suggested

as a preferred embodiment [0288] of encoding the product model, whereby a BDD represents

each [0292] consistent configuration. [0385] A user can see already performed selections,

alternatives available, which alternatives are compatible with earlier selections. User is able to

de-select earlier made configurations. [0400-0412], the iterative process of creating a list, S, of

compatible selections. [0414-0419], As an example, disclose that algorithms for determining

compatible selections are implemented using the DAG / BDD. A 'configuration assistant'

([0380] & [0422]) implements the consistency enforcement.

-a replacement component which determines replacement parts for one of existing parts and new

parts if a determination of incompatibility is made.

A new part that is not compatible may be selected ([0102], [0383], [0406]). "Even though this

selection is not compatible with other selection, force this selection, sacrificing other

selections..." [0407-0412], explains that the 'forced selection' will be added to the product

configuration, requiring new selection (replacement part) of previously selected parts. [0383],

The user is able to undo previous selections and re-select a replacement part to satisfy

compatibility. A compatible replacement component selection is shown in Fig. 3 and related text

at [0385].

Per claim 10:

-a part determination component which determines whether a selected part is compatible with the

product configuration.

A configuration assistant [0377] & [0422] uses the DAG / BDD as a part determination

component to determine whether a selected part is compatible with the production configuration.

Per claim 12:

-said part determination component includes a product table for determining whether said

selected part is one that can be added to said existing parts.

As an example, at [0242], product tables are disclosed that define components and attributes.

[0249], Tables are translated to rules. [0268], "A rule is a Boolean expression over the product

variables that should be satisfied of the configuration to be consistent" (product table used to

determined whether said new part is compatible with the product configuration). A product table

encompasses the rules of compatibility and thus determines whether a selected part is one that

can be added to existing parts.

Per claim 13:

A computer readable medium containing a data structure for storing part incompatibility

information, wherein the data structure comprises:

Lichtenberg disclosed a computer readable medium version of a compatible configuration

selection process at [0194-0195]. Lichtenberg disclosed determining incompatibility by using a

DAG that is based on rules derived from a product table [0106-0110].

-a plurality of records in a table, each record including at least two product identification values

[0237]- and example of records in a table. As an example, see [0242], combined product

descriptions with a product table to obtain the complete product model. The product description

is used to capture the structure of the product by defining the components and their attributes,

and the product tables are used to capture the concrete alternatives for the components as well as

the concrete values for the attributes at least two product identification values).

-said values representing that said products represented by said identification values are

incompatible

A DAG is used to represent all the rules regarding valid solutions (compatibility /

incompatibility). See [0274-0279]. The DAG [0277] represents a set of configurations, each of

those configurations defining value for each of the product variables.

-an indication as to product identification values which are suitable replacements for at least one

of said product identification values entered in said record.

See "The Product Model" beginning at [0234]. [0235]-"The product model is used to describe

what component the product is composed of and the inter-dependencies between these

components." [0237]-"An example of a product model..." A data structure shows a plurality of

records with identification values (such as motherboard.name=Aopen-AX6BP-AXT). Such

values are used to represent products with compatible choices represented as an attribute through

the use of rules. Suitable replacements are indicated in the rules. [0238-0240]-"Generally, the

rules can express any relationship between product variables, but the concrete rules presented in

this example can be thought of as divided into two different categories: Attribute rules

specifying the value of a certain attribute for a specific alternative...Compatibility rules

specifying general interdependencies between alternatives/attributes from different

components..." Lichtenberg discloses identification values, said values are used to represent

products that are incompatible. These 'values representing that said products represented by said

identification values are incompatible' will be recognized as incompatible when applying the

rules.

Also see [0242], "the product tables are used to capture the concrete alternatives (indication as to

product identification values which are suitable replacements) for the components as well as the

concrete values for the attributes. Further examples of suitable replacements are disclosed at

[0036-0039]. For each component, information relating to a group of alternatives is provided,

rules relating to compatibilities are defined and represented in a DAG. The DAG (has encoded

indications as to product identification values and suitable replacements) is checked during the

selections process to determine compatibility [0028-0034].

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the

manner in which the invention was made.

11.   Claims 6, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent Application Publication 2002/0165701 A1 to Lichtenberg et al.

Per claims 6 and 19:

Regarding the limitation:

-consulting a part incompatibility table to determine whether said new part is incompatible with

one or more existing parts.

Lichtenberg disclosed a part compatibility table (See [0234]-"The Product Model"). Inherently,

that which is not indicated as compatible, is incompatible. Such a determination will be

discovered by applying the rules ([0249]). Lichtenberg disclosed determining incompatibility by

using a DAG that is based on rules derived from a product table. [0274]-A DAG will represent

all the rules, such that enquiries about valid solutions to the rules can be performed efficiently."

It would have been obvious, to one of ordinary skill in the art, at the time of the invention, to

modify Lichtenberg's invention, to store 'incompatible' information in a table because one of

ordinary skill in the art would use such a data structure to logically organize information to

improve access and storage.

Per claim 11:

Regarding the limitation:

-compatibility component includes a part incompatibility table which indicates which parts are

incompatible with one another.

See rejection of claim 6 above.

12.   Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent Application Publication 2002/0165701 A1 to Lichtenberg et al., and further in view of US

Patent 6,853,978 B2 to Forth et al.

Per claims 3 and 16:

Lichtenberg failed to explicitly disclose:

-providing an alternative new part if a replacement part to said existing incompatible part is not

available.

However Lichtenberg did disclose that the selection process was iterative. Lichtenberg disclosed

that the iterative configuration process would continue until all parts selected are compatible and

parts are selected until all parts for the product are chosen. See [0403-0413] regarding the

consistent and complete configuration of a list, S', of compatible parts. Any incompatible part

selected will cause previous selections to be re-considered until an entire product is configured

with compatible parts. Inherently, for any part that is not available, a compatible alternative new part will be presented as a choice.

However, more explicitly, Forth disclosed a system and method of specifying built and configured to order intelligent electronic devices (IEDs) (Abstract). At col. 13, lines 40-47, Forth disclosed that in the case of a part being no longer available, a newer model (an alternative new part) may be provided.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention, to modify Lichtenberg's invention of configuring a product of compatible parts, to include the situation that should a part not be available, that an alternative new part may be provided, because one of ordinary skill in the art would be motivated to make an alternate selection, to substitute for a part that is not available, thereby producing a finished product. Both inventions recognized the need to simplify the selection process. Lichtenberg recognized the need to simplify the (Lichtenberg: [0026]) "computational problems inherent in developing a program for computer assisted configuration", (Lichtenberg: [0049]) enabling "the user to quickly be able to progress in the configuring of the product." Likewise, Forth recognized the (Forth: col. 1, line 40) "increased demand" for configured products, which can be (Forth: col. 2, lines 2-4) "tedious, time consuming and resource intensive, i.e. expensive, process requiring highly skilled personnel."

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned: 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman
05/23/2006